



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,622	06/28/2001	Dai Miyawaki	826.1733	4876

21171 7590 04/28/2005

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

HUYNH, CONG LAC T

ART UNIT PAPER NUMBER

2178

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,622

Applicant(s)

MIYAWAKI ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-10,12,14-16,18,20-22,24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-10,12,14-16,18,20-22,24 and 26-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed 12/27/04 to the application filed on 6/28/01, priority 6/28/00.
2. Claims 2, 4, 11, 13, 17, 19, 23, 25 are canceled.
3. Claims 29-30 are added.
4. Claims 1, 3, 5-10, 12, 14-16, 18, 20-22, 24, 26-30 are pending in the case.
Claims 1, 3, 10, 12, 16, 18, 22, 24, 28-30 are independent claims.
5. The rejections of claims 1-28 under 35 U.S.C. 112, second paragraph, have been withdrawn in view of the amendment.
6. The rejections of claims 3, 5, 12, 14, 18, 20, 24, 26 under 35 U.S.C. 102(a) as being anticipated by Stierle have been withdrawn in view of the amendment.
7. The rejections of claims 11, 17, and 23 under 35 U.S.C. 102(b) as anticipated by Johnson have been withdrawn in view of the cancellation of claims 11, 17 and 23.
8. The rejections of claims 3, 5, 12, 14, 18, 20, 24, 26 under 35 U.S.C. 102(a) as being anticipated by Stierle have been withdrawn in view of the amendment.
9. The rejections of claims 4, 13, 19, 25 under 35 U.S.C. 103(a) as unpatentable over Stierle and further in view of Cunningham have been withdrawn in view of the cancellation of claims 4, 13, 19 and 25.

Priority

10. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 6-9, the claims are indefinite since claim 4 on which claims 6-9 are dependent is canceled.

Claims 6-9 are assumed to be dependent on claim 3 in the rejections since claim 3 includes the limitations of the canceled claim 4.

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1, 10, 16, 22, 28, 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson, *Bookmark Organiser Ready*, Electronic Engineering Times, July 31, 1995, pg. 140 (pgs 1-2 as printed from ProQuest).

Regarding independent claim 10, Johnson discloses:

- obtaining an operation such as a dragging-and-dropping operation, a copying-and-pasting operation, etc. in the client (**page 1**: “If used with a Macintosh and Netscape, users can merely **drag-and-drop** WWW pages, images and text into the GrabNet window to automatically transfer their universal-source-locator (URL) along with the image or text clippings. For other browsers, **a simple copy-and paste accomplishes the same task**”)
- inserting the image data into the application of the client by dragging and dropping or copying and pasting the image data displayed on the Web browser in the client (**page 1**: “If used with a Macintosh and Netscape, users can merely **drag-and-drop** WWW pages, **images** and text into the GrabNet window to automatically transfer their universal-source-locator (URL) along with the image or text clippings. For other browsers, a simple **copy-and paste accomplishes the same task**”; drag and drop images into the client window shows that the images are inserted into the client window)
- obtaining, together with the image data, a URL at which the image data is published, information relating to the image data, and managing the URL and information as attributes of the image data (page 140: “... users can merely drag-and-drop WWW pages, **images** and text into the GrabNet window to **automatically transfer their universal-source-locator (URL) along with the image** or text clippings ... In either case, the WWW page’s title is used as the index entry within GrabNet ... The clipboard-to-folder icon adds the image or text on the clipboard to the open GrabNet window along with its originating URL”; the

fact that the WWW page's title used as the index entry within GrabNet shows that the *page's title is the information related to the image data*; and adding images on the clipboard to the GrabNet window *along with originating URL* shows that managing the URL and the page's title of the image as attribute information is performed)

Claim 1 is for a system of method claim 10, and is rejected under the same rationale.

Claim 16 is for a computer-readable storage medium of method claim 10, and is rejected under the same rationale.

Claim 22 is for a program of method claim 10, and is rejected under the same rationale.

Claim 28 is for a system of method claim 10, and is rejected under the same rationale.

Regarding independent claim 29, Johnson discloses:

- allowing a user to insert an image into an application (**page 1**: "If used with a Macintosh and Netscape, users can merely drag-and-drop WWW pages, images and text into the GrabNet window to automatically transfer their universal-source-locator (URL) along with the image or text clippings. For other browsers, a simple copy-and paste accomplishes the same task"; drag and drop images into the client window shows that the images are inserted into the client window)

- updating an image attribute in the application with a URL at which the image is available and with an image identification information relating to the image (**page**
- **140**: "... users can merely drag-and-drop WWW pages, **images** and text into the GrabNet window to automatically transfer their universal-source-locator (URL) along with the image or text clippings ... In either case, the WWW page's title is used as the index entry within GrabNet ... The clipboard-to-folder icon adds the image or text on the clipboard to the open GrabNet window along with its originating URL"; transferring their URL *along with* the image shows that the image is updated with a URL at which the image is available where the URL is considered identification information relating to the image)

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 2178

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 3, 5-6, 12, 14-15, 18, 20-21, 24, 26-27, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stierle, *BricsNet Acquires Leading Online Provider of Building Industry*, Business Wire, Oct 26, 1999, page 1 (pgs 1-3 as printed from ProQuest) in view of Cunningham, *Built for Existing Users not the First-Timer*, Computing Canada, August 5, 1997, vol. 23, Iss. 16, pg.28, 2 pgs (pages 1-3 as printed from ProQuest).

Regarding independent claim 12, Stierle discloses:

- obtaining an operation such as a dragging-and-dropping operation, a copying-and-pasting operation, etc. in the client (**page 2: “.. BricsNet’s new architectural software for IntelliCAD and AutoCAD will enable users to insert specifications and CAD symbols from the Internet into their design **via a drag-and-drop operation** ...”**)
- inserting the CAD parts data into the application of the client by dragging and dropping or copying and pasting the image data displayed on the Web browser in the client (**page 2: “.. BricsNet’s new architectural software for IntelliCAD and AutoCAD will enable users to insert specifications and CAD symbols from the Internet into their design via a drag-and-drop operation ...”**)

Stierle does not disclose obtaining, together with the CAD parts data, a URL in which the CAD parts data is published and information relating to the CAD parts data, and managing the URL and information as attributes of the CAD parts data.

Cunningham discloses that the CAD drawings, when saved in DWF (Drawing Web Format), can be posted to a web page with the URLs attached to the drawings (**page 2**: “.. By saving drawings in DWF (Drawing Web Format), you can post them to a Web page where they can be viewed with a plug-in. URLs can also be attached to your drawings ..”).

Therefore, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have combined Cunningham into Stierle for the following reason. Cunningham discloses posting the CAD drawings in the Internet with their URLs providing the advantage to incorporate into Stierle for obtaining the CAD drawings with the URL of the web page in which the CAD data is published and easily managing the URL and information relating to the CAD data via *inserting CAD drawings from the Internet along with their URLs and the specification*, which is information related to the CAD data, via drag-and-drop operation to the client application.

Regarding claim 14, which is dependent on claim 12, Stierle discloses that when the CAD parts data is dropped or pasted from the Web browser, the data is automatically converted into a CAD application format of the client and then inserted (**page 1**: “.. BricsNet's new architectural software for IntelliCAD and AutoCAD **will enable users to insert specifications and CAD symbols from the Internet into their design via a**

drag-and-drop operation ..."; the fact that users can insert CAD symbols from the Internet into their design via a drag-and-drop operation inherently shows that the CAD data is automatically converted into a CAD application format of the client before inserting since it is clear that their design is in AutoCAD application).

Regarding claim 15, which is dependent on claim 12, Stierle does not disclose referring to an original Web pages based on a URL managed as an attribute of the parts data inserted into the CAD application.

Cunningham discloses posting the CAD drawings in web format to the Internet with their attached URLs (page 2).

It would have been obvious to an ordinary skill in the art at the time of the invention was made to have combined Cunningham into Stierle for the following reason. The fact that Cunningham discloses posting the CAD drawings with their URLs to the Internet suggests that the URLs can be used as the attributes of the CAD drawings to *refer to the original Web page* where the CAD drawings are posted. This provides the advantage to incorporate into Stierle for easily tracking the original of the CAD data when exporting the CAD data to the Internet or dropping the CAD data from the Internet to any application at client.

Claims 3, 5-6 are for a system of method claims 12, 14-15, and are rejected under the same rationale.

Claims 18 and 24 are for a computer readable medium and a program of method claim 12, and are rejected under the same rationale.

Claims 20 and 26 are for a computer readable medium and a program of method claim 14, and is rejected under the same rationale.

Claims 21 and 27 are for a computer readable medium and a program of method claim 15, and are rejected under the same rationale.

Regarding independent claim 30, Stierle discloses:

- allowing a user to insert a CAD part and part image into a CAD application (**page 2**: “.. BricsNet's new architectural software for IntelliCAD and AutoCAD will enable users to insert specifications and CAD symbols from the Internet into their design via a drag-and-drop operation ...”)

Stierle does not disclose:

- updating a CAD attribute of the CAD part in the CAD application with a URL at which the CAD part and part image are available and with CAD part identification information relating to the CAD part

Cunningham discloses that the CAD drawings, when saved in DWF (Drawing Web Format), can be posted to a web page with the URLs attached to the drawings (**page 2**: “.. By saving drawings in DWF (Drawing Web Format), you can post them to a Web

page where they can be viewed with a plug-in. URLs can also be attached to your drawings ..").

Therefore, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have combined Cunningham into Stierle for the following reason. Cunningham discloses posting the CAD drawings in the Internet with their URLs providing the advantage to incorporate into Stierle for updating a CAD attribute of a CAD part in the CAD application with a URL at which the CAD part and part image are available and with CAD part identification relating to the CAD part since inserting specifications of the CAD part via dragging and dropping would change the CAD attribute of the CAD part and image.

18. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stierle and Cunningham as applied to claim 3 above, and further in view of Puttre, *CAD vendors wrap engineers in the World Wide Web*, Design News, Feb 17, 1997, vol. 52, Iss. 4, pg. 58, 4 pgs (pages 1-5 as printed from ProQuest).

Regarding claim 7, which is dependent on claim 3, Stierle and Cunningham do not disclose generating a URL list from a URL managed as an attribute of plural pieces of CAD parts data inserted into the CAD application.

Puttre discloses that a file created in the Computer Graphics Metafile (CGM) might have hot links that the user can navigate graphically by clicking on a desired balloon for further displaying the detailed drawings (page 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Puttre to include generating a URL list from a URL managed as an attribute of plural pieces of CAD parts data displayed on the Web for the following reason. Puttre discloses that a CAD drawing might have hot links represented by the balloons so that a user can click on these balloons for retrieving the display of the detailed drawing. This suggests that the hot links of the detailed drawings be in the list of URLs that includes the URL of the main CAD drawing since the detailed drawings and the main CAD drawing are from a same web page. In other words, Puttre suggests a URL list generated from a URL managed as an attribute of plural pieces of CAD parts data.

Also, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Puttre into Stierle and Cunningham since Puttre suggests a list of URL from a URL managed as an attribute of plural pieces of CAD parts data providing the advantage to incorporate into Stierle and Cunningham for inserting plural pieces of CAD parts data with their URLs into client via dragging and dropping operation.

19. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stierle, Cunningham, and Puttre as applied to claim 7 above, and further in view of Smith, Collaborate on the Web, CADalyst, Feb 1999, vol. 16, Iss. 2, pg. 58, 6 pgs (pages 1-8 as printed from ProQuest).

Art Unit: 2178

Regarding claim 8, which is dependent on claim 7, Stierle, Cunningham, and Puttre do not disclose obtaining update information about a Web page corresponding to each URL of the URL list, and notifying a user of the information.

Smith discloses a Web collaboration tools for CAD users by providing a virtual work site where the users can share and discuss designs, revisions, and project documents via the Internet as well as keep track design changes (pages 1, 4). Smith further discloses showing changes made to drawings on the meeting held over the Web with simultaneous discussion (page 2). Smith also discloses sending email notification for specific event and use instant messaging for approval and revision request (page 4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Smith into Stierle, Cunningham, and Puttre for the following reason. The fact that Smith discloses showing changes made to drawings suggests updating information about a web page corresponding to each URL in the URL list since each part of the drawings has a corresponding URL and thus, updating the drawings leads to updating the information about the corresponding web page.

Also, the fact that Smith discloses using email for notifying specific event suggests notifying the updated information to users in addition to notifying specific event to users via email. The combination of Smith into Stierle, Cunningham, and Puttre would help fast updating engineering information in the Internet as well as fast notifying the updated information to users.

20. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stierle and Cunningham as applied to claim 3 above, and further in view of Smith, Collaborate on the Web, CADalyst, Feb 1999, vol. 16, Iss. 2, pg. 58, 6 pgs (pages 1-8 as printed from ProQuest).

Regarding claim 9, which is dependent on claim 3, Stierle and Cunningham do not disclose obtaining updated information on a Web page corresponding to the inserted CAD parts data using a URL managed as an attribute of the inserted CAD parts data, and reflecting a change of information about the inserted CAD parts data.

Smith provides a virtual work site where the users can share and discuss designs, revisions, and project documents via the Internet as well as keep track design changes (pages 1, 4). Smith further discloses showing changes made to drawings on the meeting held over the Web with simultaneous discussion (page 2). Smith also discloses sending email notification for specific event and use instant messaging for approval and revision request (page 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Smith into Stierle and Cunningham for the following reason. The fact that Smith provides revisions and design changes via the Internet suggests updating the information of the web page containing the designs and reflecting the change of information about the CAD drawings on the Internet. This also suggests that changes to CAD drawings should be shown when the CAD drawings are dropped to the client. The combination of Smith into Stierle and Cunningham would help fast

Art Unit: 2178

updating engineering information in the Internet and fast notifying the updated information to users.

Response to Arguments

21. Applicant's arguments filed 12/27/04 have been fully considered but they are not persuasive.

Applicants argue that the prior does not teach or suggest inserting an image (a CAD part) into a user application (a CAD application) where CAD parts have attributes, such as a path to a library containing part, identification of a reference point for the part, and using the URL location for the image or where it is published along with information about the image, when inserting the image to the application, to update the attribute of the part in the CAD application (Remarks, pages 8-9).

Examiner respectfully disagrees.

First, there are two groups of claims. One relates to image only (claims 1, 10, 16, 22, 29) and one relates a CAD part (claims 3, 12, 18-21, 24, 26-27, 30). Therefore, the image in the first group can be any type of image. The image is not necessary to be a CAD part.

Second, the prior art does teach said inserting of an image where each image has a URL where said image is published, which is considered the attribute of the image since it includes the path showing where the image belongs. See the rejections of claims 1, 10, 16, 22, 29.

The prior art does teach said inserting of a CAD part where each image has a URL where said image is published, which is considered the attribute of the image since it

Art Unit: 2178

includes the path showing where the CAD part belongs. See the rejections of claims 1, 10, 16, 22, 29.

The prior art also does teach updating the attribute of the CAD part in the CAD application when inserting the CAD part to the CAD application. See rejection of claim 30.

Conclusion

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Munn (US Pat No. 6,177,935 B1, 1/23/01, filed 3/18/98).

Farmer et al. (US Pat No. 6,476,830 B1, 11/5/02, filed 8/2/96).

Breyer et al. (US Pat No. 6,256,625 B1, 7/3/01, filed 9/15/98).

Strauss (US Pat No. 6,246,411 B1, 6/12/01, filed 5/1/00, priority 4/28/97).

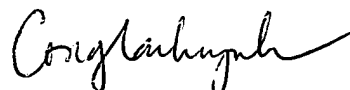
Berquist et al. (US Pat App Pub. No. 2002/0196284 A1, 12/26/02, filed 6/17/02, priority 7/1/96).

Celik (US Pat App Pub. No. 2003/0001895 A1, 1/2/03, filed 9/4/02, priority 8/7/95).

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Examiner
Art Unit 2178
4/22/05